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In re Application of	:	
TSUKADA et al.	:	DECISION ON
Application No.: 09/740,424	:	
Filing Date: 19 December 2000	:	PETITION
Attorney's Docket No.: 057329-0001	:	
For: PRINTED-CIRCUIT BOARD AND	:	UNDER 37 CFR 1.182
METHOD OF MANUFACTURE THEREOF	:	

This is a decision in response to applicant's petition entitled "Petition under 37 CFR 1.182 To Convert a National Application which was filed under 35 U.S.C. 111(a) to an Application filed Under 35 U.S.C. 371" filed in the United States Patent and Trademark Office (USPTO) on 21 January 2003. The petition requests that the above referenced application be converted from a application filed under 35 U.S.C. 111(a) to an application filed under 35 U.S.C. 371. The \$130.00 petition fee will be charged to applicant's deposit account per their authorization.

### **BACKGROUND**

On 21 July 1999, applicant filed international application PCT/JP99/03898, which claimed priority of an earlier Japanese application filed 22 July 1998. A copy of the international application was communicated to the United States by the International Bureau.

On 10 December 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or on 22 January 2001.

On 19 December 2000, applicant filed a transmittal letter for filing the international application in United States as a utility application under 37 CFR 1.53(b), which was accompanied by, *inter alia*, the filing fee and a declaration executed by the inventors. The transmittal letter did not expressly request commencement of the national procedures under 35 U.S.C. 371(f).

On 21 January 2003, applicant filed the present petition. Petitioner requests that the patent application, filed under 35 U.S.C. 111(a), be converted to an national stage application filed under 35 U.S.C. 371.

### **DISCUSSION**

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in

35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

\* \* \*

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

- 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
- 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the described in the identified international application.

A review of the application file reveals that applicants did not use Form PTO-1390 as a transmittal letter or clearly state in the transmittal letter that they were filing under 35 U.S.C. 371 or entering the national stage under PCT. In fact, the transmittal letter filed on 19 December 2000 did not identify the application as a national stage application being filed under 35 U.S.C. 371 but was entitled "Transmittal of Utility Patent Application Under 37 CFR 1.53(b)". The declaration, which accompanied the transmittal letter, was directed to the specification PCT Application No. PCT/JP99/03898.

Since applicants' transmittal letter did not request treatment under 35 U.S.C. 371 but referenced 37 CFR 1.53(b), the application was treated as an application under 35 U.S.C. 111(a) (37 CFR 1.495(g)). The transmittal letter authorized applicant's deposit account to be charged in the amount of \$710, the filing fee for a basic filing fee under 35 U.S.C. 111(a).

Applicants' reference to 37 CFR 1.53(b) in the transmittal letter is inconsistent with and would have contradicted any desire expressed in any papers filed to enter the national stage of the PCT under 35 U.S.C. 371. Application papers submitted under 37 CFR 1.53(b) are considered filed under 35 U.S.C. 111. Accordingly, the original papers deposited on 19 December 2000 were properly accepted as a filing under 35 U.S.C. 111. Since the application is deemed to have been filed under 35 U.S.C. 111(a), international application PCT/JP99/03898 is abandoned with respect to the United States.

Accordingly, applicants' request to identify the application as a 35 U.S.C. 371 filing is dismissed without prejudice.

### CONCLUSION

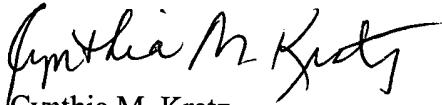
Applicants' submission on 19 December 2000 was properly treated as an application filed

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under 35 U.S.C. 111(a), with a filing date of 19 December 2000. Applicants' petition to correct the identification of the application under 35 U.S.C. 371 is **DISMISSED without prejudice**.

This application is being returned to Art Unit 2815.

A handwritten signature in black ink, appearing to read "Cynthia M. Kratz", is written over the typed name.

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